



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,786	04/14/2006	Akitoshi Kuno	2006_0530A	4651
52349	7590	06/10/2010	EXAMINER	
WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503			HARVEY, DAVID E	
			ART UNIT	PAPER NUMBER
			2621	
			NOTIFICATION DATE	DELIVERY MODE
			06/10/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
coa@wenderoth.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/575,786	KUNO, AKITOSHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	DAVID E. HARVEY	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 April 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 18-37 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 18-37 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 14 April 2006 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/14/2006</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

Art Unit: 2621

**1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.**

**2. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

**3. Claims 18-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

1) The conditional "if" terminology, i.e., recited in line 10 of claim 18, is confusing and indefinite in that the "if" state/condition appears to be inclusive of and encompass the "if not" state/condition/possibility too; i.e., in which case, the recitations that conditionally depend from the "if" recitation appears to become ineffective and drop out of the claim. Thus, it is unclear as to whether the limitations that depend from the "if" recitation are (or are not) required to be present in the claim (i.e., such recitation do not appear to be positive recitation of structure/operation as required. Clarification is needed. The examiner notes that clarification could be changed by changing "if" to read --when-- thereby indicating that the recitations dependent thereon are effective at least some of the time and, as such, required to be present as claimed.

Similar/analogous clarifications are needed with respect to the "if" recitations of each of claims 19-37.

2) In claim 19, lines 6 and 7, it is unclear as to what "the first information" refers. Clarification is needed.

3) It is unclear from the preamble of claim 37 as to whether claim 37 is directed to:

- a) A computer "program", per se, that is recorded on a medium; or
- b) To computer "program" stored on a medium when, when executed by a computer, causes the computer to perform specific operations/processing.

Clarification is needed.

**4. 35 U.S.C. 101 reads as follows:**

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

**5. Claim 37 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

A) The “computer readable medium” recitation set forth in line 1 of claim 37, given its broadest reasonable interpretation, is inclusive of non-statutory “transitory” mediums and, as such, is directed to non-statutory subject matter. This rejection can be overcome if the recitation were amended to read --non-transitory computer readable medium--.

**6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**7. Claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by notoriously well known “computer readable medium(s)”.**

- a) The examiner takes Official Notice that “computer readable media” which stored data were notoriously well known in the art at the time of the invention.
- b) As noted above in paragraph 3 of this Office action, the preamble of claim 37 appears to indicate that claim 37 is directed to a computer program, per se, recorded on a “computer readable medium”. Such a computer program constitutes non-functional descriptive material which cannot serve to distinguish that which is claimed over the prior art. As such, the examiner maintains that claim 37 is anticipated by said notoriously well known computer readable media that stored data.

**8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated US patent Publication #2001/0046190 to Miyazaki.**

As is shown in Figures 1 and 2, Miyazaki discloses a reproduction apparatus that includes:

- a) A **reproduction means** (i.e., including elements 2, 3, 4, 5, 7, 8, and 9);
- b) A **skip-operation accepting means** (i.e., including remote control input device of Figure 2 having keys (@ 25) for accepting instructions for skipping in a forward/backward direction;
- c) A **skip-time determining means** (i.e., @ 16); and
- d) A **control means** (i.e., @ 16);

wherein, under control of the **control means and skip-time determining means**, the apparatus performs the operation shown in Figure 7 that includes interrupting a normal reproduction mode to:

- a) Skip forward by an intermediate skip/jump time based on the inputting (@ 25a) of skip forward instructions; and
- b) Skip backward by a smaller small jump time based on the subsequent inputting (@ 25b) of skip backward instructions.

[See: paragraph 0049].

**9. Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated US patent Publication #2001/0046190 to Miyazaki. For the same reasons that were set forth above with respect to claim 18.**

**10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over US patent Publication #2001/0046190 to Miyazaki.**

Miyazaki disclosed an apparatus as was set forth above with respect to the rejection of claim 18. Claim 37 differs from the showing of Miyazaki only in that Miyazaki does not describe a software driven implementation of the system. The examiner maintains that a software driven implementation and implementation implemented in dedicated hardware were recognized by those of ordinary skill in the art as equivalent, wherein the software driven implementation was known to have been advantageous in terms of cost and ease of updating given the use of a general purpose computer. As such, the examiner maintains that it would have been obvious to one of ordinary skill in the art to have implemented the apparatus described in Miyazaki via a software driven computer.

**12. The following “prior art” is noted:**

A) US Patent #4,740,938 to Bierhoff:

Note: lines 59-68 of column 1; lines 1-40 of column 2; and, particularly, lines 16-18 of column 2.

B) JP Patent Document #2001-320677 to San et al.:

SEE: English language abstract.

C) US Patent Document #2005/146534 to Fong et al.:

SEE: abstract.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY  
Primary Examiner  
Art Unit 2621